

REMARKS

In response to the Office Action dated December 4, 2007, Applicants have amended the claims, which when considered with the following remarks, is deemed to place the present application in condition for allowance. Favorable consideration and allowance of all pending claims is respectfully requested. The amendments to the claims have been made in the interest of expediting prosecution of this case. Applicants reserve the right to prosecute the same or similar subject matter in this or another application.

Claims 1-16 and 18-35 are pending in this application. By this Amendment, Claims 1 and 33-35 have been amended. Applicants respectfully submit that no new matter has been added to this application. Moreover, it is believed that the claims as presented herein place the application in condition for allowance.

The Examiner has rejected Claims 1-16 and 18-32 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

The Examiner alleges that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor had possession of the invention as claimed. Specifically, it appears to be the Examiner's belief that the recitation "the plurality of different lubricating oil compositions having a phosphorous content at or below 0.08 wt.% and a sulfur content below 0.2 wt %" in independent Claims 1 and 20 is new matter because nowhere in the specification, as originally filed, is it taught that each of the different lubricating oil compositions in the library each have these levels of phosphorous and sulfur therein. The Examiner goes on to state that the only place in the specification where the phosphorous and sulfur content of lubricating oil compositions is mentioned is on page 2

where it is described how the U.S. Military Standards MIL-L-46152E and the ILSAC Standards defined by the Japanese and U.S. Automobile Industry Association have proposed that the phosphorous content be lowered to 0.08 wt% by January 2004 and below 0.05 wt.% by January 2006, and that the sulfur content be lowered to below 0.2 wt% by January 2006. However, according to the Examiner, there is no indication in the specification that the lubricating oil compositions actually present in the combinatorial library have these low levels of phosphorus and sulfur, especially since the standards set forth by the Japanese and U.S. Automobile Industry Association are only proposals, not actual laws to be enforced. In addition, the Examiner further believes that since this application was filed on October 31, 2003, which is before the dates mentioned by the standards of the Japanese and U.S. Automobile Industry Association on page 2 of the specification (i.e., January 2004 and January 2006), there is no presumption that the lubricating oil compositions in the combinatorial library of the instant application filed before January 2004 and January 2006 have a phosphorous content of at or below 0.08 wt.% and a sulfur content below 0.2 wt%.

The rejection of Claims 1-16 and 18-32 under 35 U.S.C. §112, first paragraph, is respectfully traversed.

Applicants submit that the presently recited expression “the plurality of different lubricating oil compositions having a phosphorous content at or below 0.08 wt.% and a sulfur content below 0.2 wt %” in Claims 1-16 and 18-32 is fully described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor had possession of the invention as claimed. It is well established that the test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed

reasonably conveys to the artisan that the inventor had possession at the time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. *Chiron Corp. v. Genentech Inc.*, 70 USPQ2d 1321, 1327 (CAFC 2004).

The specification clearly sets forth on page 2, lines 13-19 that

“... it would be desirable to decrease the amount of phosphorous and sulfur in lubricating oils still further, thereby meeting future industry standard proposed phosphorous and sulfur contents in the engine oil while still retaining the oxidation or corrosion inhibiting properties and antiwear properties of the higher phosphorous and sulfur content engine oils. *In order to accomplish this, a large number of proposed lubricating oil compositions must be tested to determine which compositions may be useful.*” [emphasis added]

The specification further sets forth on page 3, lines 12-15 that it would be desirable to provide combinatorial lubricating oil composition libraries which contain information related to each of the tested lubricating oil compositions which can be used to select lubricating oil compositions according to the properties desired by the end user. The specification then sets forth on page 42, lines 12-19 that

“the system may be electrically connected to a signal data collector comprising a computer microprocessor for system operation and control to collect the data from the various tests over an extended period of time to compile the combinatorial lubricating oil composition library. The database can be used to find optimum combinations for a desired product stream, and can be particularly useful when the desired product stream varies depending on market factors. *When the product requirements change, appropriate combinations can be selected to prepare the desired product.*” [emphasis added]

Based on the foregoing, one skilled in the art would clearly understand that the present invention, as set forth in the claims, is to provide combinatorial libraries that not only meet present

standards, but future standards as well. This is accomplished by formulating and rapidly testing a large number of different candidate lubricating oil compositions utilizing small amounts of each sample such that the leading lubricating oil compositions can be identified and combinatorial lubricating oil composition libraries containing information related to the tested lubricating oil compositions can be formed. Thus, the claimed combinatorial lubricating oil composition library can be found within the specification as filed to allow one skilled in the art to believe that applicants were in possession of the claimed subject matter as of the filing date. Such being the case, the claimed expression “the plurality of different lubricating oil compositions having a phosphorous content at or below 0.08 wt.% and a sulfur content below 0.2 wt %” is believed to be fully supported by the specification as to comply with the requirements of the first paragraph of 35 U.S.C. §112. Thus, withdrawal of the rejection under the first paragraph of 35 U.S.C. §112 is respectfully requested.

The Examiner has rejected Claims 1-16 and 18-35 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Each of the rejections will be addressed in turn.

With respect to Claims 1 and 33, it is the Examiner’s belief that Claims 1 and 33 are indefinite for reciting a combinatorial lubricating oil composition library that only comprises property data for a plurality of different lubricating oil compositions and does not positively recite the plurality of different lubricating oil compositions as a component of the library. Claims 1 and 33 have been amended in a manner as suggested by the Examiner. Accordingly, Claims 1 and 33 are believed fully definite as to comply with the second paragraph of 35 U.S.C. §112 and withdrawal of the rejection is respectfully requested.

The Examiner has rejected Claim 34 for indefiniteness because the recitations “the piston ring” on line 3, “the piston” and “the upper dead center” on line 4 and “the force of the fuel combustion explosion” on line 5 lack antecedent basis. Claim 34 has been amended in a manner believed to obviate the Examiner’s rejection. Accordingly, withdrawal of the rejection is respectfully requested.

The Examiner has also rejected Claim 34 for indefiniteness for the recitation “extreme wear condition”. It is the Examiner’s apparent belief that it is not clear what process is being referred to as the extreme wear condition. Although not necessarily agreeing with the Examiner, Claim 34 has been amended to recite that the extreme wear condition is associated with an extreme wear pressure test. Accordingly, amended Claim 34 is believed to be sufficiently clear and definite as to comply with the requirements for definiteness under the second paragraph of 35 U.S.C. §112. Therefore, withdrawal of the rejection is respectfully requested.

The Examiner has rejected Claim 35 for indefiniteness because the recitations “the piston ring and cylinder walls” on lines 3 and 4, and “the piston” and “the stroke” on line 4 lack antecedent basis. Claim 35 has been amended in a manner believed to obviate the Examiner’s rejection. Accordingly, withdrawal of the rejection is respectfully requested.

The Examiner has also rejected Claim 35 for indefiniteness for the recitation “hydrodynamic lubricant condition”. It is the Examiner’s apparent belief that it is not clear what process is being referred to as the hydrodynamic lubricant condition. Although not necessarily agreeing with the Examiner, Claim 35 has been amended to recite that the hydrodynamic lubricant condition is associated with a hydrodynamic wear test. Accordingly, amended Claim 35 is believed to be sufficiently clear and definite as to comply with the requirements for

definiteness under the second paragraph of 35 U.S.C. §112. Therefore, withdrawal of the rejection is respectfully requested.

The Examiner has provisionally rejected Claims 20 and 22-23 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending U.S. Application No. 10/699,510. U.S. Application No. 10/699,510 has been abandoned. Accordingly, withdrawal of the rejection is respectfully requested.

The Examiner has provisionally rejected Claims 20 and 22-30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-2, 13-18, 20-22 and 33-38 of copending U.S. Application No. 10/699,507. Applicants submit herewith a Terminal Disclaimer disclaiming that part of the term of any patent maturing from this application, which would extend beyond the term of any patent maturing from copending U.S. Application No. 10/699,507, thus overcoming the judicially created doctrine of obviousness-type double patenting provisional rejection. Accordingly, withdrawal of the rejection is respectfully requested.

The Examiner has provisionally rejected Claims 20, 22-24 and 26-30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending U.S. Application No. 10/699,508. Applicants submit herewith a Terminal Disclaimer disclaiming that part of the term of any patent maturing from this application, which would extend beyond the term of any patent maturing from copending U.S. Application No. 10/699,508, thus overcoming the judicially created doctrine of obviousness-type double patenting provisional rejection. Accordingly, withdrawal of the rejection is respectfully requested.

The Examiner has provisionally rejected Claims 1 and 17-18 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending U.S. Application No. 10/779,422 (now U.S. Patent No. 7,306,948, issued December 11, 2007). Applicants submit herewith a Terminal Disclaimer disclaiming that part of the term of any patent maturing from this application, which would extend beyond the term of U.S. Patent No. 7,306,948, thus overcoming the judicially created doctrine of obviousness-type double patenting provisional rejection. Accordingly, withdrawal of the rejection is respectfully requested.

For the foregoing reasons, amended Claims 1-16 and 18-35 as presented herein are believed to be in condition for allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,



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